

4/26/01

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

Paper No.10
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Perdue Holdings, Inc.

Serial No. 75/547,196

Douglas A. Rettew of Finnegan, Henderson, Farabow, Garrett
& Dunner, L.L.P. for Perdue Holdings, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Dan Vavonese, Acting Managing Attorney).

Before Cissel, Wendel and Holtzman, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Perdue Holdings, Inc, has filed an application to
register the mark PERDUE.COM for "providing information
regarding food products, food preparation, food storage,
recipes, and applicant via a global computer network; and
providing recipe exchange services via a global computer
network."¹

¹ Serial No. 75/547,196, filed September 3, 1998, based on an
allegation of bona fide intention to use the mark in commerce.
An amendment to allege use was filed on February 18, 1999,
setting forth a first use date and first use in commerce date of
December 21, 1998.

Registration has been finally refused under Sections 1, 2, 3 and 45 of the Trademark Act on the ground that the specimens of record fail to show use of the proposed mark in a fashion that functions as a service mark. The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The specimen of use which has been submitted consists of the following promotional or advertising brochure:

The Examining Attorney argues that the proposed mark does not function as a service mark for two reasons:

(1) the designation "perdue.com" is buried in the text of the brochure and is not used in any manner which would make it readily apparent that it is a source indicator for the recited services; and (2) the designation simply provides information about the location of applicant's website. She cites the Board's decision in *In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998), wherein the asserted mark WWW.EILBERG.COM was found to serve such an informational purpose.

Applicant contends that its specimen meets the requirements for a proper specimen in that it "is an advertising brochure that shows the mark PERDUE.COM, with the service mark designation "SM" accompanied by the following explanation of Applicant's online services with the Internet address where consumers can receive those services: '... visit our web site at www.perdue.com.'" (Brief p.4). Applicant argues that Eilberg is not applicable here, in that applicant is not using its mark merely to provide the location of its web site. Applicant insists that by the use of the designation "SM" to indicate that PERDUE.COM is a "source-identifying service mark," by the inclusion of the full Internet address after the mark, and by the absence of any "www" indicator in the mark,

applicant is clearly not using its mark simply as a web site address. Applicant argues that the mere inclusion of the term .COM should not be considered to transform an otherwise valid service mark into an informational address.

Service mark use is defined under Section 45 of the Trademark Act as occurring when a mark "is used or displayed in the sale or advertising of services." In view of the intangible nature of services, specimens are often advertising materials. There must be, however, a direct association between the mark sought to be registered and the services recited in the application, and this association must be created by a sufficient reference in the specimens to the services. See *In re Advertising and Marketing Development*, 821 F.2d 614, 2 USPQ2d 2010 (Fed. Cir. 1987); *In re Monograms America Inc.*, 51 USPQ2d 1317; *In re Johnson Controls Inc.*, 33 USPQ2d 1318 (TTAB 1994); *In re Metrotech*, 33 USPQ2d 1049 (Com'r Pats. 1993). In certain instances, although the specimens may not explicitly refer to the services identified in the application, the specimens may be fully adequate because they show use of the mark in the actual rendering or sale of the services. See *In re Metriplex, Inc.*, 23 USPQ2d 1315 (TTAB 1992); *In re Eagle Fence Rentals, Inc.*, 231 USPQ 228 (TTAB 1986).

We agree with the Examining Attorney that the initial problem with applicant's use of the designation PERDUE.COM is that it is buried in the text of the advertising brochure. Although preceded by a bullet, most of the other items are similarly presented. There is no distinguishing feature between this designation and the other facts outlined in the brochure. There is nothing to set this particular entry apart as a source identifier for particular services offered by applicant.

But even more significant is the absence of any association between the designation "perdue.com" as encountered in this brochure and the specific services identified in the application. While applicant speaks of an "explanation of Applicant's online services," we fail to find any such explanation. At best, the words "perdue.com" appear to be used as a domain name, from which persons reading this brochure might infer that applicant has a web site. The address directly thereafter simply confirms this inference. Nowhere, however, is there any indication of the nature of this web site or the particular type of information which applicant provides by this means. In fact, we are faced with the inconsistency that, although this brochure is obviously directed to retailers and not the ultimate consumers of applicant's products, the

services recited in the application appear to be directed to the ultimate consumers, i.e., a web site offering recipe exchanges, food preparation information and the like.

Thus, there is nothing in the specimens which would create an association between the designation "perdue.com" and the particular services identified in the application. The presence of the "SM" symbol does not in itself impart service mark significance to the designation, in the absence of the association of this domain name with the offering by applicant of any particular services. The mere listing of a domain name only provides the information that a web site exists.

Furthermore, this clearly is not a situation in which the mark is being used in connection with the actual rendering of the services. Applicant is simply stating in its promotional literature that such a site exists; no actual use of the designation in connection with the web site has been relied upon by applicant.

The fact that the mark which applicant seeks to register may be described as a domain name makes no difference in the application of the basic principles of service mark usage. The Examining Attorney has in fact stipulated that the mark is capable of functioning as a service mark if used in a manner which demonstrates actual

service mark usage. It is not the nature of the mark which is at issue; it is the manner in which it has been presented to the public and the resultant association, or lack of association, with the recited services which is the issue.

We agree with applicant that the circumstances here do not parallel the Eilberg case. There, the asserted mark was found to merely indicate the location of the applicant's web site. Here applicant has explicitly set forth the web site address following its presentation of the designation PERDUE.COM. We do not view the designation sought to be registered as simply another reference to a means of contacting applicant. Instead, the deficiency lies in applicant's failure to create an association of any particular services with the designation PERDUE.COM. Applicant uses the term solely as a domain name, without any supporting information as to any particular services offered under this domain name.

Accordingly, we find that the specimens of record fail to show use of the designation PERDUE.COM as a service mark.

Decision: The refusal to register under Section 1, 2, 3 and 45 of the Trademark Act is affirmed.

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